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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,537	08/28/2003	Gregory G. Kuelbs	0638MH-40982-US	9033

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LAW OFFICES OF JAMES E. WALTON, PLLC  
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EXAMINER
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SAWHNEY, HARGOBIND S

ART UNIT	PAPER NUMBER
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2885

MAIL DATE	DELIVERY MODE.
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06/08/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/650,537

Applicant(s)

KUELBS, GREGORY G.

Examiner

Hargobind S. Sawhney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 March 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-25,30,33 and 70-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-25,30,33 and 70-75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. The amendment filed on March 23, 2007 has been entered. Accordingly, Claim 34 has been canceled.
2. The Declaration under 37 C.F.R. § 1.131 filed on March 23, 2007 under 37 CFR 1.131 has been entered, and considered but is ineffective to overcome the reference Pan US Patent 6,439,249 B1.

Patent Owner must show that the teachings were reduced to practice prior to the filing date of Pan. As the evidence submitted consists only of drawings, there is no text to confirm that the depicted elements are connected or interact in the manner recited in the rejected claims. Such information cannot be gleaned from the drawings submitted. Lastly, Patent Owner has only provided conclusionary statements regarding the requirement for a showing of facts sufficient to show conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice.) Thus, Patent Owner has failed to invention of the subject matter of the rejected claims prior to the filing date of Pan.

Therefore, the claim rejections detailed in the previous non-final office action mailed on October 20, 2006 remain sustained.

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In addition, claims 21-30, 33 and 70-75 have been further examined on new ground of rejection detailed below.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 21, 22, 24, 25 and 30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 102 and 107-110 of copending Application No. 10/829,790 in view WIPO publication WO 93/00840 (Perrier et al.).

The following examination is based on the English translation of Perrier et al. Hereafter; the above-indicated English translation has been referred as "the English translated text".

The newly added claim 102, lines 1-19 and 24-31, of the copending application 10/829,790 meets all limitations, except the following, of claim 21 of the instant application. However, neither combined nor individually, the claims of the copending application recite " the LEDs being powered by the rechargeable power system without a need for connection to an AC power connection".

On the other hand, Perrier et al. discloses an outdoor umbrella apparatus (Figure 1) comprising:

- A lighting powered with an electric power system via the electrical cable 22 connected to electrical power system 3 – including batteries 3 – rechargeable with a solar energy system 2 (Figure 1, English translated abstract and text); the electrical power system 3 not requiring connection with an AC power outlet (Figure 1, English translated abstract and text).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the outdoor umbrella apparatus recited in claim 102 of the copending application 10/829,790 by providing the rechargeable power system powering the LEDs connection without needing connection with an AC power outlet as taught by Perrier et al. for the benefits of flexibility of locating the umbrella system at remote locations not having the AC power supply system, and for cost saving resulting from energy conservation.

Regarding claims 22, 24, 25 and 30, the copending application 10/829,790 in view of Perrier et al. discloses the umbrella apparatus meeting the limitations as follows:

Copending application, claim 107, lines 1-3; in view of Perrier et al. meets the limitations of the claim 22 of the instant application;

Copending application, claim 108, lines 1-4; in view of Perrier et al. meets the limitations of the claim 24 of the instant application;

Copending application, claim 109, lines 1-3; in view of Perrier et al. meets the limitations of the claim 25 of the instant application;

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Copending application, claim 110, lines 1-3; in view of Perrier et al. meets the limitations of the claim 30 of the instant application;

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 21, 22, 23, 30, 33 and 70, 72-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No.: 2,960,094 (Small) in view of US Patent NO.: 5,954,417 (Mai).

Regarding claims 21 and 33, Small discloses an outdoor umbrella apparatus (Figure 1) comprising:

- A pole portion 10 supportable by a support structure (not shown) for outdoor location (Figure 1, column 1, lines 16 and 47); an umbrella portion 11 hingedly coupled to a pole portion 10 (Figure 1, column 1, line 49); the umbrella apportion including ribs – operationally require for starching the canopy- for a rechargeable electrical power system 35 providing power to the umbrella apparatus (Figure 1, column 2, lines 29 and 30); a solar energy system 34 including a solar collector positioned above the

umbrella portion 11 (Figure 1, column2, lines 29-36); the electrical energy converted by the solar energy system conductively coupled to , and recharging the rechargeable electrical power system 35 (Figure 1, column2, lines 29-36); Positioning of the solar collector of the solar energy system 34 keeping the degree of exposure unaffected from opening and closing of the umbrella apparatus (Figure 1).

However, Small does not specifically teach the solar- powered umbrella apparatus further comprising a lighting system including a plurality of light emitting diodes "LEDs" conductively coupled to the rechargeable power system included in the umbrella apparatus.

On the other hand, Mai discloses an umbrella apparatus (Figure 1) comprising:

- An umbrella portion 3 coupled to a pole 10 (Figure 1, column 2, lines 42-46); a lighting system 83'– electrically powered lighting elements LEDs 83 conductively coupled to, and powered by the power system 82'- including a battery 82 without the need of AC power outlet (Figure 1, column 2, lines 61-67); the LEDs 83 carried by the umbrella portion – canopy -; and the LEDs 83 illuminating the area beneath the umbrella portion 3 (Figure 1, column 2, lines 42-46).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the solar-powered umbrella apparatus of Small by providing the

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LED-based lighting system as taught by Mai for the benefits enhancing utility of umbrella apparatus by illuminating the area under the umbrella portion.

Regarding claim 22, Small in view of Mai discloses the outdoor umbrella apparatus including the rechargeable battery 35 positioned adjacent the solar energy system 34 (Small, Figure 1). In addition, Small further teaches that the rechargeable batteries may be positioned anywhere, including external or internal of the post 10 (Small, Figure 1, column 2, lines 28-36).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to further modify the umbrella apparatus of Pan et al. ('249 B1) in view of Small by positioning the rechargeable batteries within the housing receiving the solar energy system, since it has been held that rearranging parts of a prior art structure involves only routing skill in the art. *In re Japikse*, 86 USPQ 70. Further, positioning of rechargeable power sources – batteries – within the housing receiving a solar energy system would operate equally well, and would be compact with less wiring.

Regarding claims 23 and 72, Small in view of Mai discloses the outdoor umbrella apparatus including:

- The solar energy system 34 positioned in a housing mounted above the top of the pole 10 and above the umbrella portion 1, and the rechargeable battery 35 positioned in a housing mounted below the umbrella portion 1 (Small, Figure 1).

Regarding claim 30, Small in view of Mai teaches the solar energy system being operationally coupled to the rechargeable electrical power system, However, neither in



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combination nor individually Small and Mai specifically teach the solar energy system being releasably coupled to the rechargeable electrical power system.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to make the solar energy system of Small in view of Mai releasable or detachably attached to the electrical power system, since it has been held that making a component removable is a merely a matter obvious engineering choice, and involves only routine skill in the art. USPQ 348, 349 (CCPA 1961). Further, using a solar energy system, which is detachable from the rechargeable electrical power system would facilitate repair, replacement or maintenance of the umbrella apparatus.

Regarding claim 70, Small in view of Mai teaches the solar energy system meeting the limitations in similar manner as that applied to claim 30 discussed above.

Regarding claims 73-75, Small in view of Mai discloses the outdoor umbrella apparatus (Mai, Figures 3 and 4) including a plurality of tubular ribs 20' supporting the umbrella portion 30' – canopy-; each of the tubular ribs 20' carrying plurality of LEDs 83' (Mai, Figures 3 and 4, column 3, lines 47, 56-61); the configuration of the tubular ribs – shape, and relative positioning of the LEDs 83' – allowing the LEDs 83' shine beneath the umbrella portion (Mai, Figure 3); the LEDs being moved with articulation – resulting from opening and closing of the umbrella apparatus – of the umbrella apparatus (Mai, Figures 3 and 4); and each of the tubular ribs 20' including a channel – hollow portion receiving a portion of a conductor 831' (Mai, Figure 4, column 3, lines 47-51).

7. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No.: 2,960,094 (Small) in view of US Patent NO.: 5,954,417 (Mai) as

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applied to claim 21 above, and further in view of WIPO publication WO 93/00840 (Perrier et al.).

The following examination is based on the English translation of Perrier et al. Hereafter, the above-indicated English translation has been referred as “the English translated text”.

Regarding claim 24, Small in view of Mai discloses the umbrella apparatus including a rechargeable electric power system charged with a solar energy system as applied to claim 21 discussed in section 6 above. However, neither in combination nor individually, Small and Mai teaches the rechargeable power system adapted to receive power from an AC power outlet.

On the other hand, Perrier et al. discloses an outdoor umbrella apparatus (Figure 1) comprising:

- A lighting powered with an electric power system via the electrical cable holder 17 connectable to electrical power system 3 – including batteries 3 – rechargeable with a solar energy system 2 (Figure 1, English translated abstract and text).

Further, Perrier et al. teaches the umbrella apparatus including the rechargeable electrical power system capable of receiving power from an AC power outlet through a power plug 14 (Figure 1, English translated abstract and text).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to further modify the outdoor umbrella apparatus of Small in view of Mai by providing the rechargeable power system capable of receiving power from the AC

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power outlet as taught by Perrier et al. for the benefits of redundant power sources desirable for high operational reliability and availability of the umbrella apparatus.

Regarding claim 25, Small in view of Mai and Perrier et al. discloses the umbrella apparatus further including a pole 9 receivable in a removable support structure – lower portion including a sleeve with a retaining fastener - (Perrier et al., Figure 1).

8. Claim 71 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No.: 2,960,094 (Small) in view of US Patent NO.: 5,954,417 (Mai) as applied to claim 21 above, and further in view of US Patent 2,863,466 (Small '466).

Small in view of Mai discloses the outdoor umbrella apparatus including: a top housing receiving the solar energy system 35– broadly interpreted as a cap - and a rechargeable battery 35 – broadly interpreted as a rechargeable electrical power system - positioned adjacent the solar energy system 34 (Small, Figure 1).

Small does not specifically teach: the top cap used to hingedly connecting the umbrella portion to the pole portion; and the rechargeable electrical power system received in the top cap portion. However, Small further teaches that the rechargeable batteries may be positioned anywhere, including external or internal of the post 10 (Small, Figure 1, column 2, lines 28-36).

On the other hand Small '466 discloses an umbrella apparatus (Figure 1) including an umbrella portion – canopy - (not shown) supported by a plurality of ribs each connected to a top cap 27 hingedly connecting the umbrella portion to the pole 28 (Figure 1, column 2, lines 20-29).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to further modify the umbrella apparatus of Small in view of Mia by positioning the rechargeable batteries within the housing receiving the solar energy system, since it has been held that rearranging parts of a prior art structure involves only routing skill in the art. *In re Japikse*, 86 USPQ 70. Further, positioning of rechargeable power sources – batteries – within the housing receiving a solar energy system would operate equally well, and would be compact with less wiring.

### ***Response to Amendment***

9. Applicant's arguments filed on August 7, 2006 with respect to the 35 U.S.C. 103(a) rejections of claims 21-25, 30, 33 and 71-75; and the obvious-type double patenting rejections of claims 21, 22, 24, 25 and 30 have been fully considered but they are moot.

As discussed in section 2 above, the Declaration under 37 C.F.R. § 1.131 filed on March 23, 2007 under 37 CFR 1.131 has been considered but is ineffective to overcome the reference Pan US Patent 6,439,249 B1. Therefore, claim rejections based on Pan have been sustained.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hargobind S Sawhney whose telephone number is 571 272 2380. The examiner can normally be reached on 8:30 AM - 4:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jong-Suk (James) Lee can be reached on 571 272 7044. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

6/5/2007

/Hargobind S. Sawhney/

Examiner, Art Unit 2885